**Docket No.: PF-0489-1 CON**



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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| Applicants: | Tang et al. | | |
| Title: | HUMAN MEMBRANE-SPANNING PROTEINS | | |
| Serial No.: | To Be Assigned | Filing Date: | To Be Assigned |
| Examiner: | To Be Assigned | Group Art Unit: | To Be Assigned |

Commissioner for Patents
Box Patent Application
Washington, D.C. 20231

**SUBMISSION UNDER 37 CFR § 1.821-1.825 OF SEQUENCE LISTING**

Sir:

With respect to the filing of the instant **CONTINUATION** application under 37 CFR 1.53(b) of pending prior application Serial No. 09/039,307, filed on March 13, 1998, originally entitled HUMAN MEMBRANE SPANNING PROTEINS, Applicants hereby submit a paper copy of the "Sequence Listing" as disclosed in the application.

Furthermore, in accordance with the requirements of 37 CFR §§ 1.821-1.825, Applicants hereby submit one (1) diskette containing the computer-readable information for the "Sequence Listing" of the above-identified application. The diskette complies with the requirements of 37 CFR § 1.824 and is IBM PC compatible using a UNIX operating system with PERL Program.

The content of the "Sequence Listing" paper copy is identical to the computer readable copy, as required under 37 CFR § 1.821(f).

Applicants respectfully point out that the Sequence Listing being submitted with the instant continuation application differs from the Sequence Listing filed with the parent utility application, in that the instant Sequence Listing includes an additional polypeptide sequence, labeled as SEQ ID NO:8. The polynucleotide sequence encoding the polypeptide sequence of SEQ ID NO:8 is included in the instant Sequence Listing as SEQ ID NO:25. Applicants submit that the inclusion of this polypeptide sequence does not constitute new matter, as this polypeptide sequence is encoded by a polynucleotide sequence disclosed in the parent utility application (labeled therein as SEQ ID NO:24). The Examiner's attention is directed to *Ex parte Ayers and Scott*, 108 USPQ 444 (BPAI 1955), in which the Board found that:

> If a statement of a so-called inherent property of a material is to be added to an application after filing, without raising the charge of new matter, it must be a property which would be obvious to those skilled in the art from the very nature of the material.

Applicants submit that the polypeptide sequence of SEQ ID NO:8 is inherent to the polynucleotide sequence now indicates as SEQ ID NO:25 (mislabeled as SEQ ID NO:24 in the Sequence Listing of the parent application), and that the polypeptide sequence of SEQ ID NO:8 would be obvious to one of skill in the art, based on the polynucleotide sequence of SEQ ID NO:25 and the disclosure in the specification of the parent application. Specifically, it was disclosed in the parent application that MSP-8 is encoded by the polynucleotide of SEQ ID NO:25 (p. 29, lines 7-13); MSP-8 is 914 amino acids in length (p. 29, line 15); MSP-8 has eight potential N glycosylation sites at residues N503, N585, N770, N804, N810, N831, N836, and N890 (p. 29, lines 15-17); MSP-8 has two potential cAMP- and cGMP-dependent protein kinase phosphorylation sites at residues T211 and T286 (p. 29, lines 17-18); MSP-8 has twelve potential casein kinase II phosphorylation sites at residues T87, S245, S271, S364, S366, T411, T597, T652, T663, S795, T870, and S876 (p. 29, lines 18-19); MSP-8 has one potential glycosaminoglycan attachment site at residue S477 (p. 29, line 20); MSP-8 has thirteen potential protein kinase C phosphorylation sites at residues T68, T84, T98, T207, T232, S366, S483, T563, T580, T594, T597, T601, and S672 (p. 29, lines 20-22); and MSP-8 has eleven cysteine residues at residues C125, C187, C200, C205, C210, C223, C250, C267, C308, C386, and C421 (p. 29, lines 25-26). Based on these disclosed characteristics of MSP-8, one of skill in the art would know that MSP-8 has the polypeptide sequence of SEQ ID NO:8. Since the polypeptide

sequence of SEQ ID NO:8 was inherently disclosed in the parent application, Applicants respectfully submit that inclusion of this polypeptide sequence with the instant continuation application would not be new matter.

Furthermore, with the submission of the instant continuation application, Applicants are correcting an unintentional and obvious error in the parent application. This unintentional and obvious error was the omission of the polypeptide sequence of SEQ ID NO:8 in the parent Sequence Listing, although it was clearly referenced in the parent and instant specifications. As a result of this omission, the polypeptide and polynucleotide sequences of SEQ ID NO:9-34 were mislabeled as sequences SEQ ID NO:8-33 in the parent application. Based on the disclosures of the polypeptide sequences of SEQ ID NO:1-17 (pages 23 through 36), encoded by the polynucleotide sequences of SEQ ID NO:18-34, it would be obvious to one of skill in the art that the polypeptide sequence of SEQ ID NO:8, encoded by the polynucleotide sequence of SEQ ID NO:25 (mislabeled as SEQ ID NO:24 in the parent application), was missing from the Sequence Listing submitted with the parent application. Furthermore, it would be obvious to one of skill in the art that the polypeptide erroneously labeled as SEQ ID NO:8 in the parent application was actually MSP-9, based on the disclosure of MSP-9 in the specification of the parent application, and that this polypeptide was encoded by the polynucleotide sequence erroneously labeled as SEQ ID NO:25 in the parent application. Likewise, the correct identities of each of the sequences mislabeled as SEQ ID NO:8-33 in the parent application would be obvious to one of skill in the art. Applicants further note that the sequences of the Sequence Listing are identified by a Clone ID, and that the correct Clone IDs are disclosed in Table 1 on p. 24 of the parent application. Thus, it would be obvious to one of skill in the art that the Sequence Listing was missing the sequence of the polypeptide of Clone ID 1737775, disclosed as being MSP-8. Furthermore, one of skill in the art would find it routine to determine which of the sequences disclosed in the Sequence Listing of the parent application corresponded to each of the polypeptide and polynucleotide sequences disclosed in the specification.

The U.S. Court of Customs and Patent Appeals has found that the correction, in a subsequently filed application, of an error that is obvious to one of skill in the art, is not a bar to according the benefit of the parent patent application, *Riester v. Kendall* (CCPA 1947) 159 F2d 732, 72 USPQ 481. Therefore, Applicants submit that submission of the corrected Sequence

Listing in the instant continuation application does not constitute the entry of new matter, and that the instant continuation application should properly have the benefit of the parent patent application.

Thus, in accordance with the requirements of 37 CFR §§ 1.821-1.825, Applicants hereby submit the paper copy and computer-readable copy of the Sequence Listing, containing the sequences disclosed in the parent and instant applications. Any questions regarding this communication may be directed to the undersigned at (650) 845-4639 or (650) 621-8581.

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. **09-0108. This form is enclosed in duplicate.**

Respectfully submitted,

INCYTE GENOMICS, INC.

Date: March 30, 2001.

Terence P. Lo, Ph.D.
Limited Recognition (37 C.F.R. § 10.9(b) ) attached
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